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09/641,677	08/18/2000	In Ho Yoon	0630-1140P	7085

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EXAMINER

FERRIS, DERRICK W

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,677

Applicant(s)

YOON, IN HO

Examiner

Derrick W. Ferris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. **Claims 15-18** are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group II, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 06/08/04.

Claim Objections

2. **Claims 7 and 10** are objected to because of the following informalities: for claim 7 PATN should be PSTN on line 1 and the claim is also missing a period at the end of the sentence, and claim 10 is also missing a period at the end of the sentence. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 8 and 13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For claim 8 it is unclear which inter-gateway applicant is referring to in line 5 (examiner assumes applicant is referring to the remote inter-gateway). Claim 13 lacks proper antecedent basis for the term "the signal" on line 1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-3, 6, 7, 9, 10, 12 and 13** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,226,287 B1 to *Brady*.

As to **claim 1**, see figure 1 where a PSTN gateway is shown as CLS gateway 103a, a PSTN terminal is shown as 108a and an IP terminal is shown as 140. An inter-gateway is shown as either CLS gateway 103 or CLS gateway 105a.

As to **claim 2**, see figure 1 where CLS gateway 103a communicates with CLS gateway 103b and CLS gateway 105a communicates with CLS gateway 105b, also see e.g., column 6, lines 36-37 and column 10, lines 1-11.

As to **claim 3**, for remote PSTN terminals see e.g., 113b and for remote IP terminals see e.g., 112b.

As to **claim 6**, see e.g., LAN 115a which is a packet network.

As to **claim 7**, see e.g., figure 2 where the PSTN communicates with the LS gateway 103a which in turn communicates with IP workstation 112. Thus the voice signal packet travels on LAN 115.

As to **claim 9**, see similar rejection to claim 1.

As to **claim 10**, see similar rejection to claim 2.

As to **claim 12**, see similar rejection to claim 6.

As to **claim 13**, see similar rejection to claim 7.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 4, 5, 8, 11 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,226,287 B1 to *Brady* in view of U.S. Patent No. 6,404,746 B1 to *Cave et al.* ("*Cave*").

In making a proper obviousness rejection under MPEP 706.02(j), the examiner will address the following four steps:

- a) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line numbers where appropriate;*
- b) the difference of differences in the claim(s) over the applied cited references;*
- c) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter; and*
- d) an explanation why one skilled in the art at the time of the invention was made would have been motivated to make the proposed modification.*

As such to **claim 4**, for step (a) *Brady* discloses a PSTN gateway for rendering the PSTN terminal and the IP terminal to communicate with one another. *Brady* also discloses an inter-gateway for rendering the IP terminal and PSTN gateway to which the PSTN terminal is connected, to communicate with an IP terminal and PSTN terminal of a different area through the Internet. In particular, a PSTN gateway is shown e.g., as CLS G1 103 a, an IP terminal as 140, a PSTN terminal as 108a, and an Internet as 118.

For step (b) *Brady* may be silent or deficient to the further limitation wherein inter-gateway compresses each signal received from the terminals to transmit the compressed signal to the remote inter-gateway, and receives the compressed communication. In particular, *Brady* discloses that the inter-gateway (i.e., CLS) is able to perform coding/decoding, see e.g., column 2, lines 63-67 and column 3, lines 6-16, where it may be unclear that the compressing takes place through Internet to the remote inter-gateway.

Cave teaches the further recited limitation above at e.g., figure 2.

For step (c), the proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Brady* by to clarify that compression takes place over the Internet between inter-gateways.

In order to establish a prima facie case of obviousness for step (d), three basic criteria must be met. The three criteria according to MPEP 706.02(j) are as follows:

First there must be some suggestion or modification, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As such, for step (d) examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the further limitation wherein inter-gateway compresses each signal received from the terminals to transmit the compressed signal to the remote inter-gateway, and receives the compressed communication. In particular, the motivation for modifying the reference or to combine the reference teachings would be so that inter-gateways can communicate using the same

compression. In other words, in order for two gateway devices to communicate with one another they must use the same level of compression. In particular, *Cave* cures the above-cited deficiency by providing a motivation found at e.g., figure 2 where the compression is the same of G.723. Second, there would be a reasonable expectation of success since both *Brady* and *Cave* disclose communicate from a PSTN device over the Internet to another PSTN device. Thus the references either in singular or in combination teach the above claim limitation(s).

As to **claim 5**, see similar rejection to claim 4 where the compression is the same at both end points of the gateway.

As to **claim 8**, *Brady* discloses a plurality of codecs by supporting more than one card, see e.g., column 3, lines 5-16.

As to **claim 11**, see similar rejection to claim 4.

As to **claim 14**, see similar rejection to claim 8.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US006373857B1 anticipates at least the independent claims. In particular, see e.g., figure 1 where a gateway 104 or 106 acts as both an inter gateway and a PSTN gateway. In addition, the gateways 104 and 106 also perform compression for voice packets sent over the Internet (i.e., IP network 102).
- US006487196B1 should be used in combination to further clarify that no compression takes place at the edge and compression takes place in the core or IP network as shown in

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figure 3. In particular, in figure 3 an egress ITG 40 also acts as both a PSTN-gateway device since it converts PSTN signals to packets and as a inter-gateway device since it compresses decompresses the packets.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick W. Ferris
Examiner
Art Unit 2663


DWF


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 6/28/07